



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,796	12/26/2001	Mark Thompson	026595-005900US	7212
20350 7590 07/16/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER JACOBS, LASHONDA T	
			ART UNIT 2157	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/032,796	Applicant(s) THOMPSON ET AL.	
	Examiner LaShonda T. Jacobs	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 14, 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is in response to Applicants Appeal Brief filed on March 14, 2007 in which prosecution has been re-opened and claims 1-16 are presented for further examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 6, 11-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Leone, Jr. et al (hereinafter, "Leone", US Pat. No. 6,600,482).

As per claim 1, Leone discloses a method for auditing forms, the method comprising:

- issuing a request to provide a form identifier that is associated with a form (col. 7, lines 46-65);
- receiving the identifier at a host computer (col. 8, lines 1-10); and
- verifying with the host computer whether the identifier is a valid identifier for the form being used (col. 8, lines 1-10).

As per claim 6, Leone discloses:

Art Unit: 2157

- wherein the host computer includes an associated database, and wherein the identifier is verified by comparing the identifier with a list of valid identifiers in the database (col. 8, lines 1-10).

As per claim 11, Leone discloses a forms auditing system:

- host computer (col. 8, lines 1-10); and
- a database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms (col. 8, lines 1-10);
- wherein host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers with the identifiers in the database, and to produce a record in the database of the comparison (col. 7, lines 46-67 and col. 8, lines 1-10).

As per claim 16, Leone discloses a forms auditing system, comprising:

- a form identifier that is associated with a form (col. 7, lines 50-57);
- host computer (col. 8, lines 1-10); and
- a database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms (col. 7, lines 46-67 and col. 8, lines 1-10);
- wherein host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers with the identifiers in the database, and

Art Unit: 2157

to produce a record in the database of the comparison (col. 7, lines 46-67 and col. 8, lines 1-10).

As per claim 12, Leone discloses:

- a terminal having a processor, wherein the terminal is configured to receive the identifier of the form being audited and to electronically send the identifier to the host computer (col. 8, lines 1-21).

As per claim 13, Leone discloses:

- wherein the terminal is configured to produce an audit screen having a region for inputting the identifier (col. 8, lines 1-21).

As per claim 14, Leone discloses:

- wherein the terminal is configured to produce an audit screen based on information sent to the terminal from the host computer (col. 8, lines 1-21).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leone in view of Bishop et al (hereinafter, "Bishop" U.S. Pub. No. 2006/0012473).

As per claim 2, Giroux discloses:

Art Unit: 2157

- wherein the request is issued from a terminal having a processor that is in communication with the host computer (col. 7, lines 46-61 and col. 8, lines 1-10).

However, Giroux does not explicitly disclose:

- logging an error if the identifier is not valid.

Bishop discloses a system and method for securing Radio Frequency (RF) using a RF identification transaction device comprising:

- logging an error if the identifier is not valid (paragraphs 0053-0055 and 0066; Bishop discloses if the identifier entered by the user is invalid, an “invalid” or “transaction invalid” message is sent to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement or incorporate Bishop’s logging an error if the identifier is not valid in Leone’s method in order to lessen the loss associated with fraudulent usage.

As per claim 3, Leone discloses:

- wherein the request is sent from the host computer to the terminal (co col. 7, lines 46-61 and col. 8, lines 1-10).

As per claim 5, Leone discloses:

- wherein the identifier is received at the host computer from the terminal (col. 7, lines 46-61 and col. 8, lines 1-10).

As per claim 15, Leone discloses the invention substantially as claims discussed above.

However, Leone does not explicitly disclose:

- wherein the host is configured to generate an error report if the identifier of the form being audited is not valid.

Bishop discloses a system and method for securing Radio Frequency (RF) using a RF identification transaction device comprising:

- wherein the host is configured to generate an error report if the identifier of the form being audited is not valid (paragraphs 0053-0055 and 0066; Bishop discloses if the identifier entered by the user is invalid, an “invalid” or “transaction invalid” message is sent to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement or incorporate Bishop’s logging an error if the identifier is not valid in Leone’s method in order to lessen the loss associated with fraudulent usage.

5. Claims 4 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leone in view of Klingman et al (hereinafter, “Klingman”, U.S. Pat. No. 5,799,285).

As per claim 4, Leone discloses the invention substantially as claims discussed above.

However, Leone does not explicitly disclose:

- where the request is issued from a customer service operator over the phone.

Klingman discloses a secure system for electronic selling comprising:

- where the request is issued from a customer service operator over the phone (col. 9, lines 10-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Leone by implementing or incorporating a customer service operator to receive and process requests over the telephone in a timely and efficient manner.

Art Unit: 2157

As per claim 7, Leone discloses the invention substantially as claims discussed above.

However, Leone does not explicitly disclose:

- determining whether an appropriate form has already been ordered.

Klingman discloses a secure system for electronic selling comprising:

- determining whether an appropriate form has already been ordered (col. 10, lines 47-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Leone by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

As per claim 8, Leone discloses the invention substantially as claims discussed above.

However, Leone does not explicitly disclose:

- wherein if an appropriate form has not been ordered, placing an order for an appropriate form.

Klingman discloses a secure system for electronic selling comprising:

- wherein if an appropriate form has not been ordered, placing an order for an appropriate form (col. 10, lines 55-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Leone by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

Art Unit: 2157

As per claim 9, Leone discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose discloses:

- evaluating whether the ordered form is received by a user.

Klingman discloses a secure system for electronic selling comprising:

- evaluating whether the ordered form is received by a user (col. 9, lines 47-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Leone by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

As per claim 10, Leone discloses:

- transmitting an identifier for a replacement form to the host computer (col. 8, lines 10-34).

Response to Arguments

6. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 571-272-4004.

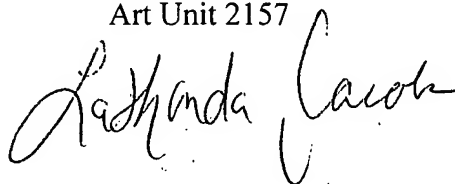
The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

Art Unit: 2157

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LaShonda T Jacobs
Examiner
Art Unit 2157



ltj
July 9, 2007